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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

22

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/264,432

Applicant(s)

GOLDMAN ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7,8,14,15,19,33-42 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7,8,14,15,19,33-42,44,46 and 47 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments with respect to the combined Perlman, Ballard, and Eldering reference not disclosing or suggesting the "overwriting" of "preexisting advertisements" of claims 1 and 34 has been fully considered is not persuasive.

The Perlman reference generally discloses a method for inserting advertisements or "banner" on the screen amidst other content (Page 13, Lines 1-3, 14-15) within an information document or web page. The reference discloses that in prior art systems with cached pages the user encounters the same banner ad each time a user accesses the page which is disadvantageous over the referenced current method wherein the banner ad changes each time a web page is displayed (Page 13, Lines 14-21). The reference subsequently discloses that the present invention may subsequently periodically insert advertisements such that they change throughout the user browsing experience (Col 13, Lines 22-30).

Accordingly, it is the examiner's opinion that in operation that the reference is disclosing a manner in which targeted advertisements from the user cache are selected and "inserted" into the information documents in a manner such that the end-user experiences changing banner advertisements similar to current methods of displaying banners wherein banner ads change each time a web page is displayed. It is unclear, however, if the "inserting" is necessarily occurring in conjunction with a "pre-existing ad" or if the "inserting" is only occurring in specially designated sections of a web page (analogous to a local insert in television advertising). The Perlman et al. reference further suggests that it is operable to "overlay advertising over any web page" to ensure that particular advertisements will be viewed

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regardless of the web site a user visits (Page 18, Lines 11-20). Taken in conjunction with the previous “insertion” teachings, it is the examiner’s opinion that the “overlay” subsequently provides suggestion to one of ordinary skill in the art the ability of the embodiment to replace a “preexisting advertisement that was included within the information document requested from the server”.

However, the newly presented claim has been amended so as to clarify that the “replacement” is an “overwrite”. As the terms “replace”, “overwrite”, and “overlay” do not appear to be explicitly defined within the specification, the examiner shall interpret the terms in view of their common usage. Per the Merriam-Webster’s Collegiate Dictionary 10<sup>th</sup> Edition, the term overlay is defined as “to lay or spread over or across : Superimpose”, the term overwrite is defined as “to write over the surface of”, and the term replace is defined as “to take the place of esp. as a substitute or successor”. In light of the specification of the instant application, the terms “overwrite” and “replacing” appear to be used interchangeably in so far as the specification discloses that the “advertisement insertion module 176 may overwrite an advertisement already included in the requested information document, thereby replacing the existing advertisement with the selected advertisement” (IA: Page 21, Lines 3-5). With respect to the Perlman et al. reference, the usage of the term “overlay” appears to be equivalent to the common usage of the term “overwrite” such that the act of “overlying” a targeted advertisement over another advertisement serves to “write over the surface of” the old advertisement so as to “replace” it with an advertisement that is deemed to be of greater interest to the viewer.

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2. Applicant's arguments with respect to the combined Perlman, Ballard, and Eldering reference not disclosing or suggesting that the "profile" is particularly weighted based on more recently versus older programming" of claim 44 has been fully considered is not persuasive. The Eldering et al. reference suggests the creation of both an average session based profile and a session based profile. The session-based profile, subsequently, gives more weight to recently viewed programming by being session based as opposed to the average profile which may weights both recently viewed as well as less recently viewed programming.

### *Claim Objections*

3. Claim 44 is objected to because the newly added limitation may be misinterpreted in light of the specification in so far as older programming may suggest that the programming itself is older as opposed to the user's viewing of the programming being less recent. Accordingly, the examiner would propose amending the limitation to read: "with more recently viewed television programming being given more weight in the profile than [older] less recently viewed television programming". Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1, 4-8, 14-15, 19, 33-42, 44, and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Ballard (US Pat No. 6,182,050), and in further in view of Eldering et al. (US Pat No. 6,457,010).

In reference to claim 1, the Perlman et al. (WO 98/56128) reference shows the schematic structure of a communications network for use with an "information retrieval system" such as the WebTV® client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the "request" for and "display" of "information documents" or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours as selected by editorial staff based either on payments or consideration that the items are novel or of general interest (Page 12, Lines 5-21). These advertisements are subsequently inserted from the "advertisement repository being stored at the client system" [220] into the retrieved "information documents" and "displayed" [105] (Page 13, Lines 22-28). Furthermore, in one embodiment the "inserted

data” or advertisements may replace or “overwrite” a “preexisting advertisement that was included within the information document requested from the server” (Page 18, Lines 11-20).

The aforementioned Perlman et al. (WO 98/56128) reference does not explicitly disclose, nor preclude, that the embodiment is operable to “compile a user profile at the client system” (Page 7, Lines 3-10). The Ballard reference discloses an embodiment wherein an “information retrieval system” [14] (Col 5, Lines 41-45, 54-64) may “insert data representing the selected advertisement” based on a “profile of the user of the information retrieval system at the client system” (Col 7, Lines 50-65) which is not “sent to the server computer” [52] for purposes of selecting advertisements to be inserted into information documents which are sent via the server (Col 12, Lines 30-67 – Col 13, Lines 1-41). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Perlman et al. reference, if necessary, to “compile a profile of the user of the information system” as taught by Ballard for the purpose of selecting the most relevant advertisements from the Perlman et al. “repository” [220] in a manner that further protects consumer privacy (Ballard: Col 1, Lines 7-60).

The combined Perlman et al. and Ballard references do not explicitly disclose, nor preclude that the “profile includes at least information associated with television programming”. The Ballard reference suggests that the “profile” may monitor “usage” (Col 7, Lines 21-25). The Eldering et al. reference discloses a method for characterizing a subscriber of an “information retrieval system”, such as a PC-TV device, (Col 7, lines 1-12) with information that is “stored locally” (Col 6, Lines 66-67 – Col 7, Line 1) and does not necessarily need to be shared (Col 2, Lines 55-67 – Col 3, Lines 1-4). The developed profile

may be based “at least information associated with the television programming viewed by the user” (Col 5, Lines 25-35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the “profile” of the combined Ballard and Perlman et al. references, if necessary, with information pertaining to the “television programming viewed by the user” when using a PC-TV as taught by Eldering et al. Such a modification would advantageously enhance the advertisement affinity ranking of Ballard since a “profile” that characterizes a viewer using both viewing and demographic information, subsequently provides additional dimensions to use when targeting advertisements (Eldering et al.: Col 2, Lines 8-11).

Claim 34 is rejected wherein the aforementioned “system” may be implemented using a “computer program product” (Perlman et al.: Page 6, Lines 11-17).

Claims 4 and 35 are rejected wherein the “act of inserting data representing the selected advertisement is conducted at the client system” (Perlman et al.: Page 18, Lines 11-20; Ballard: Col 13, Lines 4-25).

Claims 5 and 36 are rejected wherein the Perlman et al. reference teaches that information such as advertisements may be “pre-downloaded” and stored in memory on the client system (Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claims 7 and 37 are rejected wherein the “information document” is a web page in HTML format (Perlman et al.: Page 7, Lines 29-31 – Page 8, Lines 1-7).

Claims 8 and 38 are rejected aforementioned wherein the “profile” may be constructed “to further characterize the user” using a combination of user supplied demographic data, and tracking information as illustrated in Figure 1 of the Eldering et al. reference.



In reference to claims 14-15 and 39-40, the Perlman et al. reference discloses that the host server may provide supplemental information including “news” [308] and “reference information related to the content of the television programming” such as sports information provided on ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

Claims 19 and 41 are met wherein the Perlman et al. reference discloses that information may be “pushed” to the client during off-peak periods (Figure 5; Page 12, Lines 18-21; Page 20, Lines 14-30). It is well known in the art that “push” technology does not require “direct user assistance”.

Claims 33 and 42 are rejected wherein the compiling of a “profile includes an act of identifying closed captioning received from television programming” (Eldering et al.: Col 5, Lines 36-46).

Claim 44 is rejected in view of claim 1 wherein the combined Perlman et al., Ballard, and Eldering et al. reference disclose an information retrieval system that compiles a profile of a user including at least television viewing information that is utilized in conjunction with the selecting, insertion, and display of an advertisement in an information retrieval document. As aforementioned, the Ballard in conjunction with Eldering et al. reference is generally relied upon in conjunction with “compiling a profile . . . including at least information associated with television programming viewed by the user”. With respect to the newly added limitation, the examiner interprets the claim such that “older programming” refers to programming that was viewed less recently during previous sessions as opposed to the programming itself actually being “older programming” (ex. re-runs of “Giligan’s Island”). The Eldering et al. reference discloses that television viewing information may be used to

“compile a profile” wherein “more recently viewed television programming [is] given more weight in the profile than older programming” such that the profile is generated based entirely on “more recently viewed television programming” associated with the viewing session (Col 4, Line 34-41).

Assuming arguendo, the claim does not necessarily require that the “profile” is necessarily the result of television viewing information associated with multiple viewing sessions. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the aforementioned combined reference such that the “more recently viewed television programming [is] given more weight in the profile than older programming” in conjunction with a “weighted” average session value (Col 12, Line 52 – Col 13, Line 20) since it was known in the art to time decay transactions in conjunction with the development of profiles (ex. Kramer et al.: Col 26, Line 45-52) for the purpose of providing a means for reflecting that transactions that occurred long in the past may have less relevance in determining today’s preferences, hence providing a means for capturing/reflecting a viewer’s changing preferences over time.

Claim 46 is rejected wherein the Perlman et al. reference suggests that the “inserted data” or advertisements may replace a “preexisting advertisement that was included within the information document requested from the server” (Page 18, Lines 11-20).

Claim 47 is rejected in view of claim 43 wherein the “selected advertisement is selected prior to requesting the information document” such that the advertisements within the “advertisement repository” are further partially “based on a most recently viewed television program”. The Ballard reference suggests that the user is sent advertisement target criteria

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and “prior to requesting the information document, and based at least in part of the profile” the “client system” selects which of these advertisements are to be “stored” in the “advertisement repository at the client system” and subsequently inserted/displayed (Col 12, Lines 41-64). Presumably, the ads to be displayed would be delivered during off-peak hours and stored in a repository as taught by Perlman et al.

### *Allowable Subject Matter*

7. Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In particular, there is no suggestion in the combined art of record such that the “most recently viewed television program is solely used to select the advertisement”. The previous grounds of rejection were based on the premise that only one program was viewed during the session. However, the examiner’s interpretation of claim 44 is such that it now requires the viewing of multiple programs namely a “newer” and an “older” program.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

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- The Lotspiech et al. (US Pat No. 6,345,289) reference discloses a method and system wherein the intermediate system may customize the advertisements received by the client system from the server without returning information about the user's interests or preferences to the server.
- The Shaw et al. (US Pat No. 5,809,242) reference discloses a system for providing targeted banner advertisements that may be "overwritten" based on a profile associated with information associated with television programming.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB  
November 5, 2003

  
JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
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